Serial No.: 10/567,677   PU030178
Customer No. 24498
Amendment Dated August 19, 2010
Reply to Office Action of June 2, 2010

REMARKS

The Office Action mailed June 2, 2010 has been reviewed and carefully considered. No new matter has been added.

Claims 1-20 are pending.

Claims 1-18 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0203873 to Gray (hereinafter "Gray") in view of U.S. Patent No. 7,047,036 to Shaheen et al. (hereinafter "Shaheen") further in view of U.S. Patent No. 7,054,634 to Watanabe et al. (hereinafter "Watanabe"). Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Gray in view of Shaheen and Watanabe further in view of U.S. Patent Publication No. 2004/0156372 to Hussa (hereinafter "Hussa").

It is to be noted that the independent claims in the case are Claims 1, 7, and 13.

It is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest "providing, responsive to said receiving step, a user with a menu option selection in a mobile device for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN)", as now recited in amended Claim 1.

Moreover, it is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest "wherein a user is provided, responsive to receiving over said wireless network said location of said wireless local area network (WLAN), with a menu option selection for selecting a distance or distance range from a wireless service area of the wireless network to said location of said wireless local area network (WLAN)", as now recited in amended Claim 7.

Further, it is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest "providing, responsive to said mobile device receiving the location of the wireless local area network (WLAN), a user with a menu option selection for selecting a distance or distance range from the wireless service area of the wireless network to the location of the wireless local area network (WLAN)", as now recited in amended Claim 13.

We initially note that the Examiner has admitted that Gray in view of Shaheen does not teach or suggest the above reproduced limitations of Claims 1, 7, and 13 (see, e.g., Office Action dated June 2, 2010, pp. 3, 7, and 10). Hence, the Examiner relied upon Watanabe for

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disclosing the same. The Applicant respectfully disagrees with the Examiner's reading of Watanabe and, hence, the rejections based on the same.

Against the aforementioned limitations of Claims 1, 7, and 13, the Examiner has cited column 8, lines 19-39 of Watanabe. Column 8, lines 17-40, inclusive of cited lines 19-39 of Watanabe are reproduced in their entirety as follows:

The operation of the multiservice terminal 140 set in the user-designation selection mode will then be described. With the user-designation selection mode, the location manager 49 regularly acquires positional information from the GPS receiver interface 48, wherein when a specified time or a specified distance advances, or when the reception power level of the wireless system selected by its own station drops to create a need for switching (calculated from the data received from the GPS receiver), the location manager 49 sends the positional information to the management server 110, as in the same way as during calling, via the common signaling wireless network interface 47 (which also serves as positional registration to the management server 110). The location manager 49 awaits a response from the management server 110 and receives a responded available wireless system list. The location manager 49 transfers the available wireless system list to the display 46 to pop-up display it on the display 46. When a desired wireless system is elected by the user from the displayed available wireless system list, information on the selection is transferred to the network selecting section 44, wherein the network selecting section 44 establishes connection to the desired wireless system, in the same way as switching of the wireless system during calling and communication.

Thus, positional information of the multiservice terminal 140 is regularly acquired. Distance (i.e., "when a specified distance advances") is used to trigger the sending of the positional information from the location manager 49 to the management server 110, whereby the management server 110 then sends a list of available wireless systems to the location manager 49. However, the list of available wireless systems, and **NOT** their respective

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distances, is provided on display 46. The user then selects one of the available wireless

systems, and **thereafter** information (noting that what the information includes is not

specified) on the selection is transferred to the network selecting section 44. However, the

network selecting unit 44 is not the display 46 and, hence, the user is **never** shown the

information on the selection and hence the approach of Watanabe at least differs from the

limitations of Claims 1, 7, and 13 in that the **information** (presuming, since it is not

explicitly disclosed in the first place, that such information is or includes the respective

distances from the systems in the list of available wireless systems to the multiservice

terminal) **is never seen by the user, let alone using a menu option selection and thus,**

cannot be used to make a selection by the user in the first place. Lastly, we note that

Watanabe does not include even one occurrence of the word "menu", let alone the remaining

limitations corresponding to the same recited in Claims 1, 7, and 13.

Allowing a user at the mobile terminal as per Claims 1, 7, and 13 to specifically tailor

search results (regarding the locations of multiple WLANs) to a particular distance or range

as per the above claims allows greater versatility, and enables a user to specifically take into

account his or her particular circumstances with respect to driving towards a WLAN. For

example, should a user notice that he or she has a certain (i.e., limited) amount of gas left, the

user may want to restrict the range to a smaller range than that used by the communication

network itself to provide the specified WLANs. In this way, the user may reduce the overall

number of WLANs that have to be evaluated by the user. These and many other attendant

advantages are present in the approach claimed in the above claims versus the prior art.

Hence, it is respectfully asserted that neither Gray nor Shaheen nor Watanabe teach or

suggest all of the above reproduced limitations of Claims 1, 7, and 13. Moreover, it is

respectfully asserted that the remaining reference Hussa does not cure the deficiencies of

Gray in view of Shaheen in view of Watanabe, and is silent with respect to the above

reproduced limitations of Claims 1, 7, and 13.

For example, Hussa also does not include even one occurrence of the word "menu",

let alone "mention option selection, let alone providing a user with the same, let alone the

remaining detailed limitations involving the same recited in Claims 1, 7, and 13. In fact,

Hussa teaches away from the same. For example, Hussa discloses that "at least one network

access point external to the mobile communication network is selected on the basis of

predetermined criteria" (Hussa, para. [0022]). Thus, in contrast to providing a user with a

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menu option selection responsive to receiving the location(s) of the wireless local area network(s), Hussa obtains and stores such criteria before hand, i.e., before the location(s) of the WLAN access point(s) has been sent to the user. For example, Figure 5 of Hussa shows data repository 406/407 storing "selection criteria", where the data repository corresponds to a network element (see, e.g., Hussa, para. 0042) and not to a mobile device to allow the same to provide such menu selection option responsive to receiving the location information as recited in Claims 1, 7, and 10. Hence, in this regard, Hussa actually teaches away from the above reproduced limitations of Claims 1, 7, and 13.

Hence, Hussa also does not teach or suggest all of the above reproduced limitations of Claims 1, 7, and 13.

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Thus, Claims 1, 7, and 13 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above.

Claims 2-6 and 19 directly or indirectly depend from Claim 1 and, thus, include all the limitations of Claim 1. Claims 8-12 directly or indirectly depend from Claim 7 and, thus, include all the limitations of Claim 7. Claims 14-18 and 20 directly or indirectly depend from Claim 13 and, thus, include all the limitations of Claim 13. Accordingly, Claims 2-6 and 19 are patentably distinct and non-obvious over the cited references for at least the

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reasons set forth above with respect to independent Claim 1, Claims 8-12 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 7, and Claims 14-18 and 20 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 13.

Accordingly, reconsideration of the rejections is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of June 2, 2010 be withdrawn, that pending Claims 1-20 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no further additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicants' Deposit Account No. 07-0832.

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